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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,315	02/16/2001	Taeyoung Yoon	49563-1 (72021)	7054

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EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER

LIU, HONG

ART UNIT PAPER NUMBER

1624

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/788,315	Applicant(s) YOON ET AL.	
	Examiner Hong Liu	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-26, 30, 42-130, 133-146, 154, 155 and 162 is/are pending in the application.
- 4a) Of the above claim(s) 16-26, 43-130, 133-146, 154, 155 and 162 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7 and 9 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 10-15, 30 and 42 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 3-26, 30, 42-130, 133-146, 154-155, and 162 are pending in this application.

This action is in response to the applicants' amendment and reply filed on December 23, 2003.

Response to Arguments

Applicants' arguments and amendments filed on December 23, 2003 have been fully considered but they are not persuasive. Rejections of Claims under 35 U.S.C. § 102(b) are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Rejection of claims 3-8 under 35 U.S.C. 102(b) as being anticipated by Hori et al., Chem Abstract 80:890 is maintained. Applicants argued that the compounds of Hori have a benzyl substitute at the R1 position whereas R1 of the instant compounds does not have the definition that covers a benzyl group. This argument is not persuasive. Although there is no explicit definition of benzyl for R1, the R1 group, as defined, could have a benzyl substitution. R1 can be C1-C3 alkyl. According to the definition of alkyl on page 26 of the specification,

various substituents of the various formulae are optionally substituted, including Ar, R1, R2, and R3 of Formula 1, and such substituents as recited in the sub-formulae such as Formulae 1a and the like. When substituted, those substituents (Ar, R1, R2, and R3) may be substituted by other than hydrogen at one or more available positions,

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typically 1 to 3 or 4 positions, by one or more suitable groups such as those disclosed herein.

The specification goes on to define those suitable groups such as a phenyl.

Therefore, R1 can be methyl substituted with a phenyl, which is benzyl.

Claims 3-5, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by McCapra et al., Chem Abstract 79: 125387. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS computer search report and the compounds having RN 49784-80-7 and 49784-81-8.

Claims 3-5, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al., Chem Abstract 93:114448. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS computer search report and the compounds.

Claims 3-5, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Teranishi et al., Chem Abstract 114:101506. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS computer search report and the compounds.

All other 102 rejections are hereby withdrawn in view of applicants' arguments.

Claim Rejections - 35 USC § 103

Rejection of claims 3-15 under 35 U.S.C. § 103(a) as being unpatentable over Cox et al. (WO 98/38174) is hereby withdrawn in view of applicants' amendment of R3.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

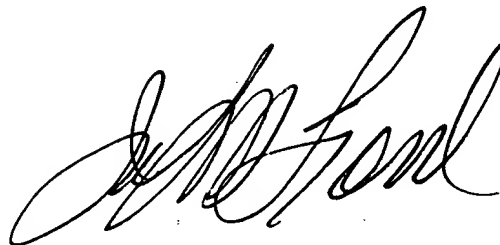
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisors, Mukund Shah or James Wilson can be reached at (703) 308-4716 or (571) 272-0661, respectively. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 358-1235.



JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT

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Mukund Shah
Supervisory Patent Examiner
Art Unit 1624

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January 29, 2004